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09/581,286	06/28/2000	Bruce C. Ross	47-138	4095

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EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/581,286

Applicant(s)

ROSS ET AL.

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 and 19-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 1631

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-34 are pending.
2. In response to restriction requirement filed 05/03/03 applicant elected, without traverse, Group I, claims 1-10, 16-18. Claims 11-15, 19-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected groups.

Further, applicant elected polypeptide SEQ ID 424, with traverse. Applicant requests examination of SEQ ID Nos 300 and 425 because they are "very similar" to SEQ ID No. 424. However, the similarity is not explained and no core structure required for a common utility is disclosed for these polypeptides. Further, applicant requests co-examination of proteins PG13, PG35, PG 47, and PG50 because they "include a TonB III box". However such moiety is not present in the elected polypeptide (it has only 40% identity with the TonIII Box; see Table 5, p. 43 of specification); further, said moiety is not disclosed as a common core structure required for a common utility. The restriction requirement is still deemed proper and is therefore made FINAL. Amendment of claims 1-10, 16-18 to read on elected invention is requested.

Art Unit: 1631

***Sequence Listing***

3. The Sequence Listing was approved by STIC for matters of form.

***Claim Objections***

4. Claims 1-10, 16-18 are objected because they do not reflect the elected subject matter. Applicant elected polypeptide of SEQ ID 424. The claims do not reflect the elected subject matter. Amendment of the claims to read on the polypeptide SEQ ID 424 is requested.

5. Claims 2,5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of base claim 1. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 U.S.C. § 101/ 112-1***

The following is a quotation of the 35 U.S.C. § 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

Art Unit: 1631

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

The examiner is using the following definitions in evaluating the claims for utility.

*"Specific"* - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

*"Substantial"* - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. The following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use and, therefore, do not define "substantial utilities":

- A. Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved.
- B. A method of treating an unspecified disease or condition. (Note, this is in contrast to the general rule that treatments of specific diseases or conditions meet the criteria of 35 U.S.C. § 101.)
- C. A Method of assaying for or identifying a material that itself has no "specific and/or substantial utility".
- D. A method of making a material that itself has no specific, substantial, and credible utility.
- E. A claim to an intermediate product for use in making a final product that has no specific, substantial, and credible utility.

*"Credible"* - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

*"Well-established"* - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

Art Unit: 1631

See also the MPEP at §§ 2107 - 2107.02.

6. Claims 1-10, 16-18 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by either specific and/or substantial utility or a well established utility.

The claims are drawn to polypeptide SEQ ID No. 424 or homologs or fragments thereof.

The specification discloses polypeptide of SEQ ID NO: 424, or polypeptide PG2, which is encoded by polynucleotide SEQ ID 160 (see page 19, Table 1, in particular). The specification fails to provide sufficient objective evidence of any activity for the claimed protein. Specification mentions that said polypeptide shows low, 28%, amino acid sequence similarity to outer membrane protein of *Bacteroides thetaiota* *micron*. No particular utility for the latter protein is demonstrated. Identifying a polypeptide as having a limited homology to the claimed polypeptides does not indicate what function it might have. Assignment to a prior art family of polypeptides is generally insufficient to meet the utility requirement unless such assignment would allow the artisan to assign a specific and substantial use to the new member of the polypeptide family. Skolnick et al. (Trends in Biotech., 18(1):34-39, 2000) disclose that the skilled artisan is well aware that assigning functional activities for any particular

Art Unit: 1631

polypeptide or polypeptide family based upon sequence homology is inaccurate, in part because of the multifunctional nature of polypeptides (see, e.g., "Abstract" and "Sequence-based approaches to function prediction", page 34). Even in situations where there is some confidence of a similar overall structure between two polypeptides, only experimental research can confirm the artisan's best guess as to the function of the structurally related polypeptide (see in particular "Abstract" and Box 2). Thus, the homology-based assignment of the claimed polypeptide does not appear to provide evidence of a specific and substantial utility based on the knowledge of the skilled artisan and the data presented in the instant specification.

Further, the claimed polypeptides comprising fragments or homologs of polypeptide SEQ ID No. 424 are not supported by a substantial utility because no substantial utility has been established for the claimed subject matter because the utility of polypeptides comprising fragments or homologs of polypeptide SEQ ID No. 424 utility depends on the activity/function of the polypeptide SEQ ID 424 itself which is yet to be discovered by further research. The apparent need for such research clearly indicates that the polypeptide is not disclosed as to a currently available or substantial utility.

Because there is no indication of the specific and substantial use for the claimed polypeptides, the claimed products do not comply with the utility requirement

Art Unit: 1631

of 35 U.S.C. § 101. The examiner does not find an adequate nexus between the evidence of record and the asserted properties of the claimed subject matter. Applicant should explicitly identify a specific, substantial, and credible utility for the claimed invention and establish a probative relation between any evidence of record and the originally disclosed properties of the claimed invention.

7. Claims 1-10, 16-18 are also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

***Conclusion.***

8. No claims are allowed

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to

Serial Number: 09/581286

Page 8

Art Unit: 1631

5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

January 22, 2004

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Michael Borin', is written below the printed name and title.